

## **REMARKS**

The Office Action dated June 30, 2006, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claim 4 has been canceled. The Abstract, Specification and claims 1-3 have been amended. No new matter is presented. Claims 1-3 are pending and respectfully submitted for consideration.

### **Amendments to the Abstract**

The Abstract was amended to correct minor informalities. No new matter has been added.

### **Amendments to the Specification**

The Specification was amended to correct minor informalities. No new matter has been added.

### **Rejection Under 35 U.S.C. § 112**

Claims 1-4 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action took the position that the claims are unclear. The Applicant has amended the claims to clarify that the claims are directed to a method. The Applicant respectfully submits that all claims are in compliance with U.S. patent practice.

The Office Action took the position that the following terms recited in the claims were unclear: "highest progress", "IDA", "difficulty level", grains that are "angular", "the smallest size of grit that is economically possible", "the "size between the maximum and 40% of the maximum".

The Applicant has deleted the terms "angular", and "the smallest size of grit that is economically possible" from the claims. In addition, the Applicant has changed the term "highest progress" to "greatest advancement". The Applicant further submits that "the size between the maximum and 40% of the maximum" means 40% of 1 millimeter, which is the maximum size disclosed. Support for this explanation can be found in claim 1 of the application as originally filed.

The Applicant respectfully submits that IDA is defined as the cutting difficulty index or score which is used in the art to classify stones in groups from 1 to 5, and it is also known as hardness. The cutting difficulty score, ideally, can be used to determine the maximum possible advancement and the consumption of grit and strips. The difficulty level refers to the difficulty in cutting stone in a particular classification. Classifications range from group 1--being the least difficult to cut, to group 5--being the most difficult to cut.

The Applicant respectfully submits that with the above explanation and the deletion of some of the terms considered indefinite, that the claims are in compliance with U.S. patent practice. Accordingly, the Applicant respectfully requests withdrawal of the rejection.

**Rejection Under 35 U.S.C. § 102(b)**

Claims 1-4 were rejected under 35 U.S.C. § 102(b) as being anticipated by Okanishi et al. (U.S. Patent No. 5,697,359, "Okanishi"). Okanishi discloses an abrasive blade with a reduced cutting noise. As noted above, claim 4 has been canceled. The Applicant traverses the rejection and respectfully submits that claims 1-3 recite subject matter that is neither disclosed nor suggested by Okanishi.

With respect to claim 1, the Applicant respectfully submits that Okanishi fails to disclose or suggest the claimed features of the invention. Claim 1, as amended, recites that the sound level is less than 80 db at a distance of 1.5 meters from the measuring apparatus and low in pitch. In contrast, Okanishi merely discloses the lowest noise value of 89 db as shown in Table 1 and 87 db as shown in Table 2 at a distance of 1 meter from the working position.

According to U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “Every element of the claimed invention must be arranged as in the claim. . . . [t]he identical invention must be shown in as complete detail as is contained in the patent claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). The Applicant respectfully submits that Okanishi does not disclose or suggest the features of the invention as recited in claim 1. Accordingly, Okanishi does not anticipate claim 1, nor is claim 1 obvious in view of Okanishi. As such, the Applicant submits that claim 1 is allowable over the cited art.

Claims 2 and 3 depend from claim 1 and are allowable for at least the same reasons.

### **Conclusion**

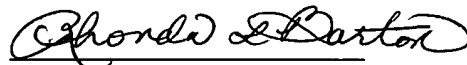
The Applicant respectfully submits that claim 1 is allowable. Claims 2 and 3 depend from claim 1 and incorporate the patentable aspects thereof. Accordingly, the

Applicant respectfully submits that these dependent claims are also allowable. As such, the Applicant respectfully requests withdrawal of the rejections, allowance of claims 1-3, and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 027318-00004.**

Respectfully submitted,



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Enclosures: Substitute Abstract  
Substitute Specification  
Marked-Up Copy of Substitute Specification  
Petition for Extension of Time (two months)